

### **REMARKS**

Applicant cancelled claims 71 and 217 and amended claims 67 and 68 to further define Applicant's claimed invention. Applicant amended the drawings to include new Figs. 1A-1C and 18A-18C. Applicant amended the specification to include a description of new Figs. 1A-1C and 18A-18C. New Fig. 1A is supported at least by claims 78, 102, 103, and 104 as originally filed and Fig. 15 of U.S. Patent No. 5,593,409, which is incorporated by reference in the specification on page 7, lines 1 and 2. New Fig. 1B is supported at least by claim 25 as originally filed. New Fig. 1C is supported at least by claim 43 as originally filed. New Figs. 18A and 18B are supported at least by claim 75 as originally filed. New Fig. 18C is supported in the specification at least on page 4, lines 20 and 21. No new matter has been added.

In the Office Action, the Examiner rejected claims 57-120 and 146-259 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending U.S. Application No. 09/572,518 ("the '518 application"). Applicant is submitting concurrently with this Amendment a Terminal Disclaimer of the terminal part of any patent granted in the present application which would extend beyond the expiration of any patent granted on the '518 application.

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims. In particular, the Examiner contended that the subject matter of claims 75, 78, 82, and 104 were not illustrated. Applicant submits that one of ordinary skill in the art would understand the subject matter of the claims without the necessity of drawings. Nonetheless, in the interest of expediting prosecution, Applicant amended the drawings to include new Figs. 1A-C and 18A-C, which show examples of the claimed limitations of claims 69, 75, 78, 82, 100, and 104, respectively.

Specifically, for claim 75, Applicant added new Figs. 18A and 18B, which show examples of grooves that have a horizontal cross-sectional shape that is U-shaped and box-like shaped, respectively. A "V-shaped groove" is already illustrated in Figs. 16 and 18.

For claim 69, Applicant added new Fig. 18C which shows spaced apart surface projections.

For claims 78 and 104, Applicant added new Fig. 1A, which shows an example of an implant having upper and lower surface that are at least in part arcuate, and a cap for closing an access opening.

For claim 82, Applicant added new Fig. 1B, which shows an example of an implant having a leading end, a trailing end, and sides that form a circle.

For claim 100, Applicant added new Fig. 1C, which shows a graphical representation of a motion preserving device in accordance with 37 C.F.R. § 1.83(a). Applicant submits that motion preserving devices are well known in the area of spinal implants and that a detailed illustration is not essential for a proper understanding of the invention. An example of a motion preserving device is shown in U.S. Patent No. 4,349,921 to Kuntz, submitted in Applicant's Information Disclosure Statement of April 17, 2000. Kuntz teaches an implant that permits motion of the adjacent vertebral bodies relative to one another after installation of the implant. (See, for example, col. 12, lines 59-61 and Figs. 12-14). The implant surface of the claimed invention can be formed on various spinal implants including, but not limited to implants that are motion preserving devices.

Some of the pending claims include a recitation of a material or composition, or a combination of a material or composition (see, for example, claim 28). MPEP § 601.01(f) states that situations in which drawings are usually not considered necessary for the understanding of the invention under 35 U.S.C. 113 (first sentence) are: (A) Coated articles or products...[and] (B) Articles made from a particular material or composition..." (page 600-14, column 2 (August 2001)). Thus, Applicant submits that the claims that recite a material or composition, or combination thereof, do not require illustration.

Applicant respectfully submits that all of the limitations claimed and required to be illustrated are shown in the drawings. It is submitted that the objection to the drawings under 37 C.F.R. § 1.83(a) has been overcome.

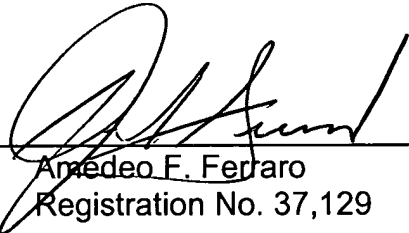
In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

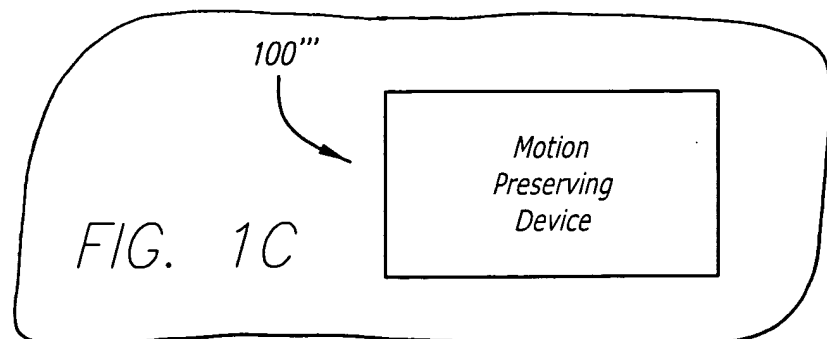
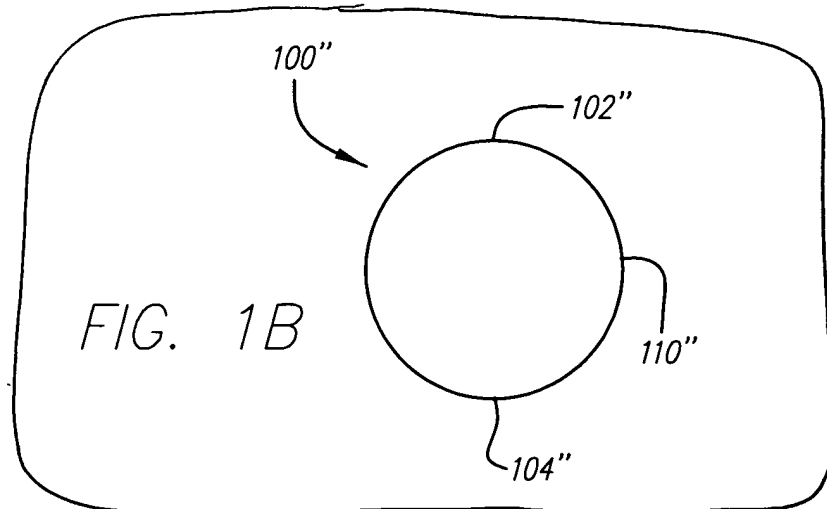
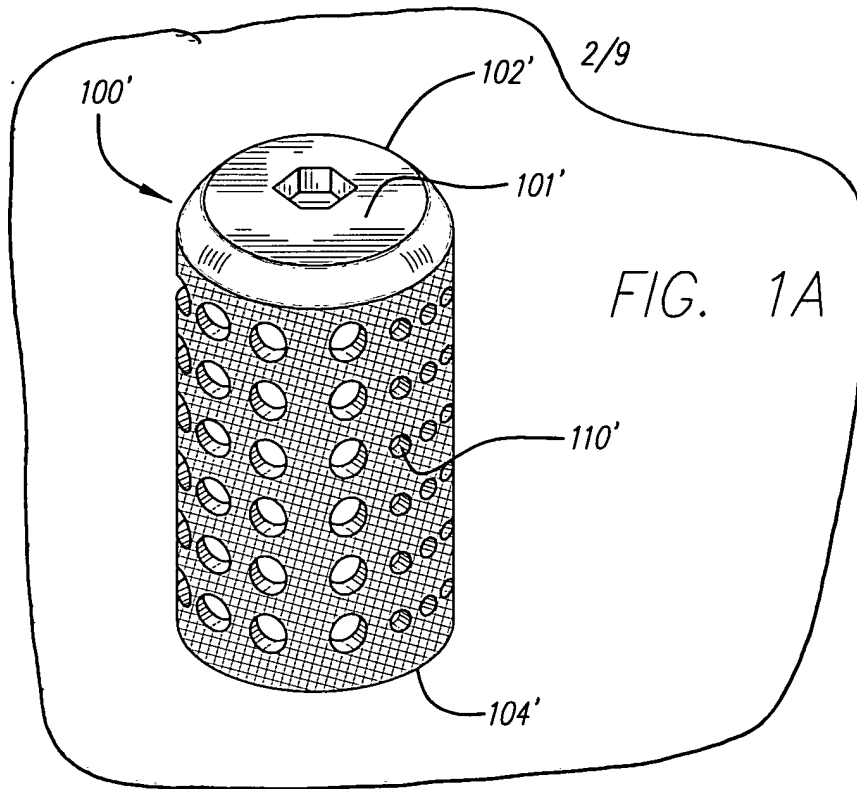
Respectfully submitted,

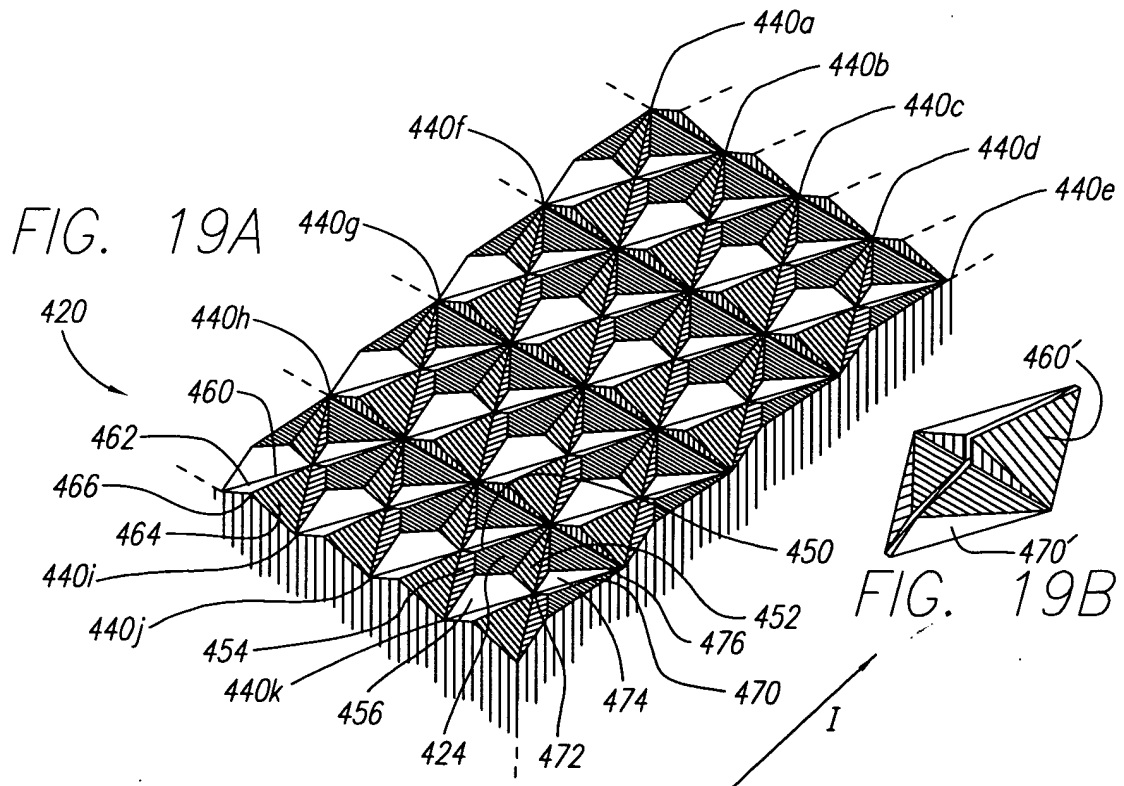
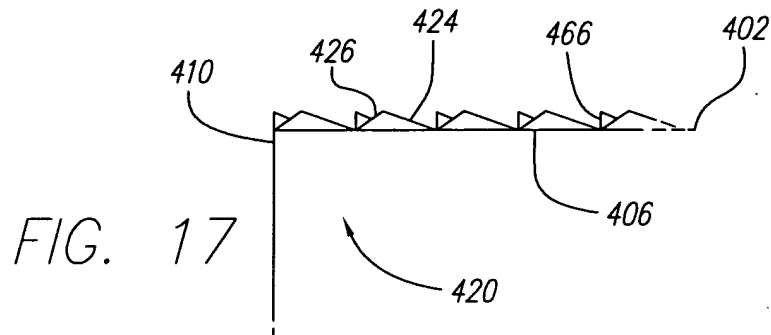
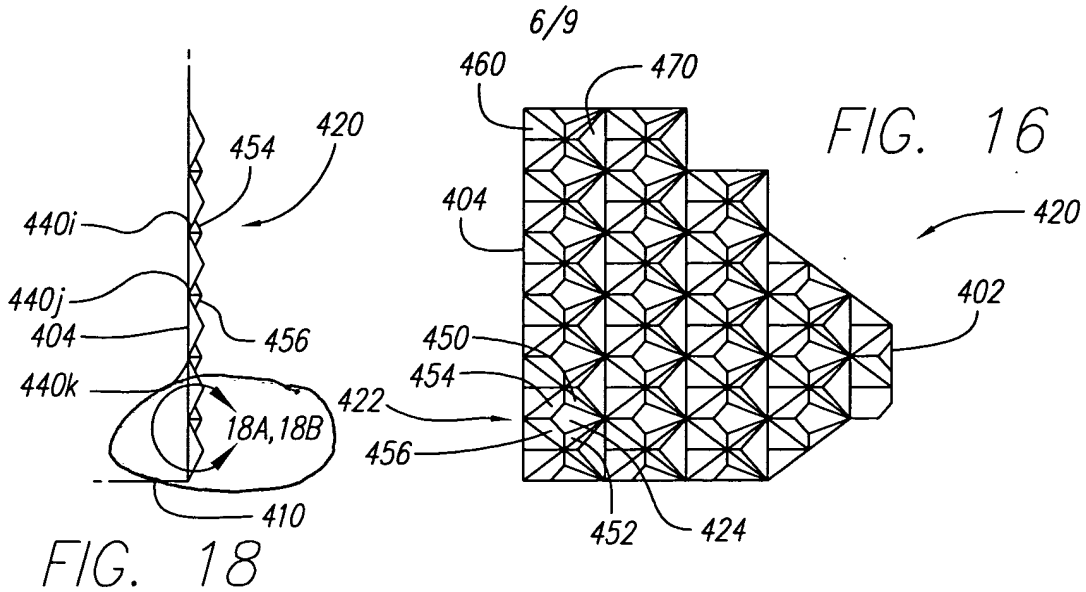
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Dated: 3-1-04

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